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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,828	11/09/2004	Koichi Nishimura	2593-0148PUS1	3768
2292	7590	04/06/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			SHAHER, RICKY D	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/508,828

Applicant(s)

NISHIMURA, KOICHI

Examiner

Ricky D. Shafer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 13 January 2006.

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-3 and 10-12 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some \* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/23/04 & 12/23/04.

4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date. \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's election with traverse of group I (claims 1-3 and 10-12) in the reply filed on 01/13/2006 is acknowledged. The traversal is on the basis that there would be no burden to examine all of the claims of the nonelected invention along with the elected invention. This is not found persuasive because the lack of unity of invention mailed on 12/13/2005 is based on the fact that the inventions are not so linked to form a single inventive concept under PCT 13.1 because, under PCT 13.2, they lack the same or corresponding special technical features. Continued search and examination of claim(s) to a nonelected invention including claims have substantially different special technical features is a prima facie showing of burden. Applicant may overcome the requirement for lack of unity of invention by presenting an allowable linking claim.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 4-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 01/13/2006.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahiko ('221).

Takahiko discloses an optical film composed of a thermoplastic resin film having an alicyclic structure (see paragraphs 006 and 007) obtained by using a melt extruding machine (see

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paragraphs 0016-0017), characterized in that said thermoplastic resin film satisfies a relation of the formula recited by applicant over the whole surface of the film (see paragraphs 004, 006, 0012 and examples 1-4 in paragraph 0024) when an angle made by the extruding direction of the thermoplastic resin film from the melt extruding machine and a slow phase axis at each point is  $\alpha$ , and a retardation amount at each point is  $Re$ , wherein  $Re$  is 10 nm or less (see paragraph 0024) and wherein the optical film is a protective film of a polarizer and the protective film is provided on one surface or both surfaces of the polarizer (see paragraph 0013) via an adhesive layer (see paragraph 0023) and wherein the optical film provides for a phase difference obtained by performing a stretch processing on the optical film (see paragraphs 0008-0011 and examples 1-4 in paragraph 0024).

5. Claims 1-3 and 10-12 are objected to because of the following informalities:

In claim 1, line 6, the period after " $Re$ " should be properly placed after the formula.

Appropriate correction is required.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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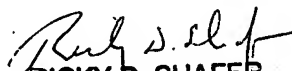
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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

March 31, 2006

  
RICKY D. SHAFER  
PATENT EXAMINER  
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